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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/079,337 | 02/20/2002 | Rory L. Fisher | 10011093-1 | 7947 |

7590 09/04/2003
AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
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Loveland, CO 80537-0599

EXAMINER
DIMYAN, MAGID Y

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
| 2825 | |

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/079,337

Applicant(s)

FISHER, RORY L.

Examiner

Magid Y Dimyan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 8 and 15 is/are rejected.
- 7) ☒ Claim(s) 1-7, 9-14 and 16-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Claim Objections

2. Claims 1, 8 and 15 are objected to because of the following informalities: in claim 1, line 2, delete "circuit;" and insert -- circuit, --; in line 13, insert -- register -- after "group; in line 13, delete "relationship", and insert -- relationships --; in line 14, insert -- each -- after "said". The same objects apply to claims 8 and 15 (at different line numbers). Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 8 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,539,520 to Tiong, et al (hereinafter, Tiong). Referring to these claims, Tiong discloses a system and method for generating a hardware description code and a boundary-scan description language (BSDL) file for an IC as claimed herein. Tiong uses a flat netlist of the IC to create the BSDL, as cited herein (see Figs. 1 and 3e), and cites how the boundary scan chain port names (i.e., JTAG registers) are determined and used to create the BSDL file (see Fig. 3e; column 10, line 59 to column 11, line 17; column 12, lines 17 - 33). Tiong thus recites all the limitations of these claims.

Allowable Subject Matter

5. Claims 2 – 7, 9 – 14 and 16 – 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: these claims pertain to (a) traversing at least one hierarchical netlist that describes portions of the netlist in creating the BSDL file; and (b) the JTAG registers use JO, JT and JI registers in the generation of the BSDL files. Prior art does not teach these inventions.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pub. No. US 2003/0145286 to Pajak et al teaches a self-contained embedded test design environment, which comprises an ease-of-use design utility for assisting a circuit designer in quickly implementing a circuit embedded test design flow.

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Pub. No. US 2003/0145297 to Cote et al cites a sign-off method for use in verifying of embedded test structures in a circuit design by extracting a description of all embedded test structures from a circuit description to create a test connection map file, and verifies the connections of the test structures to create circuit pins or nets.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Magid Y Dimyan whose telephone number is (703) 308-1354. The examiner can normally be reached on Monday - Friday 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S Smith can be reached on (703) 308-1323. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

Magid Y Dimyan
Examiner
Art Unit 2825

MYD
August 25, 2003


VUTHE SIEK
PRIMARY EXAMINEE